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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,809	07/25/2003	Frank Lesniak	034266	2534
28143	7590	04/20/2006	EXAMINER	
NATTER & NATTER 501 FIFTH AVENUE SUITE 808 NEW YORK, NY 10017			ALI, SHUMAYA B	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,809

Applicant(s)

LESNIAK ET AL.

Examiner

Shumaya B. Ali

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6 and 8-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,5,6 and 8-14 is/are allowed.
- 6) ☐ Claim(s) 15,18-21 is/are rejected.
- 7) ☐ Claim(s) 16,17,22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> .                  |

***Response to Amendment***

In response to the office action mailed on 11/1/05 the Applicant has amended claims 1,14,15,17,18, cancelled claims 2,4,7, and incorporated new claims 21-23. Currently claims 1,3,5,6,8-23 are pending.

***Response to Arguments***

1. Applicant arguments regarding restriction made between apparatus and method claims are persuasive. Therefore former restriction made has been withdrawn.
2. Applicant's arguments filed on 1/25/06, with respect to independent claim 1 have been fully considered and are persuasive. The rejection made to claims 1,3,5,6,8-14 has been withdrawn.
3. Applicant's arguments filed on 1/25/06 with respect to claim 15 have been fully considered but they are not persuasive. Farrell discloses every structural limitation cited in claim 15. Clarification of the structural limitation are provided below, see rejection made to claim 15 made under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Farrell US Patent No. 6,935,857 B1.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claims 15, 18-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Farrell US Patent No. 6,935,857 B1**

As to claim 15, Farrell in figures 1-5 discloses an oral appliance, a mouth guard or an orthodontic device, therefore capable of being used as an oral prophylaxis (protective treatment for teeth) comprising:

- An arched shaped occlusal plate (1)
- Maxillary buccal (97) and lingual (6) walls
- A dentition encasement material (3,4)
- A generally planar lower mandibular face (11)
- A labial force dispersal shield (wall of 17 in front of the mandibular incisor area 11)
- The mandibular face having a pair of molar zones in registration with mandibular molar teeth (molar areas are inherently located at the distal portion of 11 or proximal to 5 in fig.5)
- A pair of opposed peripheral framing braces, each framing brace extending downwardly from a buccal periphery of the mandibular face at the molar zone (see labeled fig. 5 attachment below)
- The dentition encasement material covers the molar zones and an incisor zones of the mandibular face (col.1 lines 55-65 and col.2 lines 1-30), the incisor zone being registered with the labial force dispersal shield (see fig.3)

Regarding “the buccal periphery of the mandibular face being free of downward extension intermediate the labial force dispersal shield and the framing braces” these structural limitations are disclosed by Farrell as stated above, and “to facilitate oral breathing” is considered recitation of intended use which is not given patentable weight.

As to claims 18-21, Farrell discloses structure necessary for performing the method steps cited in claims 15-21 (see structural limitation cited in claim 15). Therefore, it would have been obvious to one of ordinary skills in the art to perform the method steps of claims 15-21 using the device disclosed by Farrell.

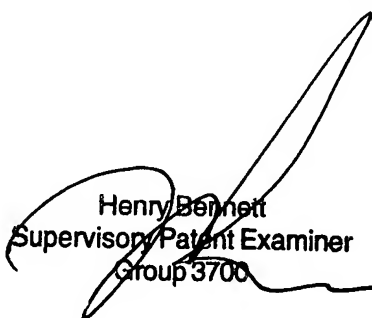
*Allowable Subject Matter*

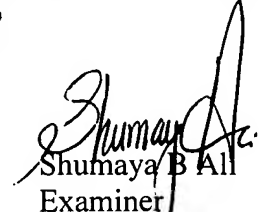
3. Claims 1,3,5,6,8-14 are allowed.
4. Claims 16-17,22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry Bennett  
Supervisor, Patent Examiner  
Group 3700

  
Shumaya B. Ali  
Examiner  
Art Unit 3743

4/16/06

prior art fig. 5

U.S. Patent

US 6,935,857 B1

